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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

08350.1647-00

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Signature _____

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Application Number

10/026,758

Filed

12/27/2001

First Named Inventor

Gregg A. MCCLELLAND

Art Unit

2676

Examiner

Brautigam, Alysa N.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

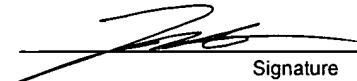
This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)
- ☐ attorney or agent of record.
Registration number _____
- ☒ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 53,056


Signature

Frank A. Italiano

Typed or printed name

202-408-4460

Telephone number

November 2, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

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PATENT
Customer No. 22,852
Attorney Docket No. 08350.1647-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Gregg A. MCCLELLAND et al.)	Group Art Unit: 2676
)	
Application No.: 10/026,758)	Examiner: Brautigam, Alys N.
)	
Filed: December 27, 2001)	
)	
For: SCHEMATIC COLORIZATION)	Confirmation No.: 9791
SYSTEM)	

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request a pre-appeal brief review of the final Office Action mailed August 2, 2005 ("Office Action"). This Request is being filed concurrently with a Notice of Appeal and prior to the filing of an Appeal Brief, in accordance with the Official Gazette Notice of July 12, 2005. In the Office Action, claims 1-14 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,883,313 ("*Kim*"); and claims 15-28 were rejected under 35 U.S.C. § 103(a) as unpatentable over *Kim* in view of U.S. Patent No. 5,966,310 ("*Maeda*"). Applicants submit that the rejections are based on clear legal and factual errors, as explained below.

I. Section 102(b) rejection of claims 1-14

The § 102(b) rejection of claims 1-14 based on *Kim* is improper because (1) the reference does not teach each and every feature of claim 1; and (2) the Examiner's interpretation of claim 1 is unreasonable.

The § 102(b) rejection is factually deficient because *Kim* does not teach each and every feature of claim 1. Claim 1 recites, *inter alia*, “establishing a color scheme, wherein the color scheme includes a color, representing a visible wavelength in the electromagnetic spectrum, associated with at least one of the features in the set” and “automatically colorizing the at least one feature based on the color scheme to generate a colorized schematic.” As further explained in the Amendment filed May 23, 2005 (“Amendment”), binary qualities (such as positive and negative, which are used to effect a photomask phase transition), as disclosed by *Kim*, does not constitute a “color scheme” including a color representing a visible wavelength in the electromagnetic spectrum, as claimed. As also explained in the Amendment, automatically assigning VLSI design elements as either a 0° or 180° phase transition, as disclosed by *Kim*, does not constitute the “automatically colorizing” feature, as claimed. *See* Amendment at 14-15.

The § 102(b) rejection is legally deficient because the Examiner’s interpretation of the terms “color” and “colorizing” in claim 1 is unreasonable. The Examiner takes the position that phase coloring VLSI design elements by assigning them binary qualities (e.g., either a 0° or 180° phase transition) is consistent with the terms “color” and “colorizing” of claim 1. According to the Examiner, *Kim*’s “*binary quality* . . . establishes the color scheme, that is, a phase shift in color of 0 to 180 degrees.” Office Action at 2. This interpretation of claim 1 is not proper.

As M.P.E.P. § 2111 requires, “[d]uring patent examination, the pending claims must be “given . . . [their] broadest reasonable interpretation consistent with the specification” (internal citations omitted). Although limitations from the specification are not to be read into the claim, the proper claim interpretation must be consistent with the specification. *See* M.P.E.P. § 2111; *see also In re Bond*, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990). “The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those

skilled in the art would reach.” M.P.E.P. § 2111. In addition, “the words of the claim must be given their plain meaning” M.P.E.P. § 2111.01.

In this case, a person skilled in the art of preparing and publishing schematic drawings, would not readily understand the terms “color” and “colorizing” of claim 1 to mean a binary quality or assigning binary qualities. Further, a skilled artisan would not readily understand the term “color scheme,” as recited in claim 1, to mean “a phase shift in color of 0 to 180 degrees.” See Office Action at 2. The terms “color” and “colorizing” must be given their plain meaning.

For at least the foregoing reasons, and as further explained on pages 14-17 of Applicants’ Amendment, the § 102(e) rejection is improper.

II. Section 103(a) rejection of claims 15-28

The rejection of claims 15-28 is legally and factually deficient because *prima facie* obviousness has not been established based on *Kim* and *Maeda*.

A case for *prima facie* obviousness has not been established at least because the requisite motivation to combine the references is lacking. The Federal Circuit has opined that “virtually all [inventions] are combinations of old elements.” See, e.g., *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998) (citations omitted). An examiner may find every element of a claimed invention in the prior art but mere identification is not sufficient to negate patentability. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). The court explained that “the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” *Id.*

Furthermore, determinations of obviousness must be supported by evidence on the record. See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001), 59 USPQ2d 1693, 1696-98 (finding that the factual determinations central to the issue of patentability, including conclusions

of obviousness by the Board, must be supported by “substantial evidence”). The desire to combine or modify references must be proved with “substantial evidence” that is a result of a “thorough and searching” factual inquiry. *See In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002), 61 USPQ2d 1430, 1433 (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52). Additionally, the Federal Circuit has clearly stated that the evidence of a motivation or suggestion to modify a reference must be “clear and particular.” *In re Dembicziak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

In this case, the Examiner merely provided descriptions of how the cited references allegedly teach certain features without providing “clear and particular” reasons why a skilled artisan “would select the elements from the cited prior art references for combination in the manner claimed.” *See id*; *see also In re Rouffet*, 149 F.3d at 1357, 47 USPQ2d at 1457. For example, the Examiner alleged that a skilled artisan would have “integrate[d]” the teachings of *Kim* and *Maeda* “to . . . make the schematic more easily manipulated and viewable by a generic user.” Office Action at 11-19. That allegation is not properly supported and does not show that a skilled artisan would have combined the references as alleged. The Examiner provided no “clear and particular” evidence from the applied references, the nature of the problem to be solved, or the knowledge of persons of ordinary skill in the art regarding a generic user easily manipulating and viewing a schematic. The Examiner’s allegation that both references “refer to their inventions as usable in a CAD environment” does not support the alleged combination. Office Action at 11, 17-19. Indeed, M.P.E.P. § 2143.01 makes clear that: “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.”

Applicants also note that “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. M.P.E.P. § 2141.02. Here, the Office Action has not established that any of claims 15-28, taken as a whole, would have been obvious in view of the applied art.

Applicants submit that the Examiner is impermissibly using teachings of the present application in hindsight to piece together disclosures of the cited references. Such picking and choosing among isolated disclosures amounts to improper hindsight reconstruction, and is prohibited. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).


For at least the reasons explained above, and as explained in Applicants’ Amendment (see pages 19-22), the requisite motivation to combine *Kim* and *Maeda* is lacking. Moreover, as further explained in Applicants’ Amendment (pages 17-22), even if these references were combined, the resultant combination would not yield all of the features of Applicants’ claims. Accordingly, the Examiner failed to establish a case for *prima facie* obviousness with respect to claims 15-28. As such, the § 103(a) rejection of claims 15-28 is improper.

In view of the foregoing, Applicants request a pre-appeal brief review of the rejections in the Office Action. Applicants submit that claims 1-28 are in condition for allowance and request a favorable action.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 2, 2005

By: 
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Reg. No. 53,056